

Application No. 09/173,858

to co-pending U.S. Patent Application No.09/173,854, filed on 16 October 1998, now
U.S. Patent No. 6,125,391, entitled MARKET MAKERS USING DOCUMENTS FOR
COMMERCE IN TRADING PARTNER NETWORKS.

In the Claims:

Please cancel claims 17-60, without prejudice.

REMARKS

In the Official Action mailed 2 October 2001, the Examiner requested an update of the status of the cross references on page 1; rejected claims 1-34, 36, and 39-71 for obviousness-type double patenting; rejected claims 1, 17, 18, 39, 61 and 72 under 35 USC §103(a); and rejected claims 35 and 37-38 under 35 USC §103(a).

Applicant has amended the specification and canceled claims 17-60. Claims 1-16 and 61-72 remain pending. Each of the Examiner's rejections is respectfully traversed below.

Request for Update of Cross References

Applicant has amended the specification to update the cross references as required.

Rejection of Claims 1-34, 36, and 39-71 for Obviousness-Type Double Patenting

Applicant encloses a first Terminal Disclaimer in compliance with 37 CFR §1.321(c) to overcome the rejection based on obviousness-type double patenting as to claims 1-16 and 61-72 over U.S. Patent No. 6,226,675 B1. Also, a second Terminal disclaimer is provided in connection with related U.S. Patent No. 6,125,391. Accordingly, reconsideration is requested in view of the Terminal Disclaimers.

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Claims 17-60 are being submitted in a continuation application. Such claims are directed to tools for building definitions and compiling data structures. The claims in the related issued Meltzer, et al. patents do not relate to such structures, and therefore the double patenting rejection should not be applied to such claims.

Rejection of Claims 1, 17, 18, 39, 61 and 72 under 35 USC § 103(a)

The Examiner rejected claims 1, 17, 18, 39, 61 and 72 under 35 USC § 103(a) as unpatentable over Bayeh et al. (U.S. Patent No. 6,012,098). Applicant notes that the Bayeh et al. reference was filed on 23 February 1998, and would qualify as prior art only under 35 USC § 102(e). Without admitting that Bayeh et al. is in fact prior art, Applicant requests reconsideration on the merits of the Bayeh et al. reference.

The Bayeh et al. patent teaches a process for translating a document expressed in XML into a document expressed in HTML for the purposes of presentation of the content of the document. See column 4, lines 37-47 of Bayeh et al. Bayeh et al. teaches that the format (XML) of the document being retrieved can be "isolated" from the format (HTML) to be used for presentation of the document by providing a translation mechanism.

The Examiner applies Bayeh et al. to claim 61. Claim 61 reads as follows:

*61. A method for programming a commercial transaction in a network, comprising:
defining a machine-readable definition of an input document for a node in the network
including resources to execute a process in the transaction, and a machine-readable definition
of an output document for the node, the definitions of input and output documents comprising
respective descriptions of sets of storage units and logical structures for the sets of storage
units; and
providing interpretation information for logical structures to the node.*

Bayeh et al. fails to disclose "a node in the network including resources to execute a process in the transaction," where the transaction is a "commercial transaction" as stated in the claim. In fact, Bayeh et al. is unrelated to commercial transactions.

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The Examiner appears to suggest that the XML datastream in Bayeh et al. corresponds to the claimed "input document" for a commercial transaction, and the HTML datastream of Bayeh et al. corresponds to the claimed "output document" for commercial transaction. In Bayeh et al, both datastreams are produced from a single document that is formatted in XML using a document type definition DTD and then translated using a style sheet into HTML. The translation technology applied to a single document, as described in Bayeh et al. is not related to the concepts of an "input document" and of an "output document" for commercial transactions as recited in claim 61.

The Examiner admits that the Bayeh et al. patent does not teach the limitation in claim 61 of "providing interpretation information...." The Examiner relies on allegedly well-known prior art to satisfy this limitation. However, it is not clear what the Examiner considers to be interpretation information for the logical structures in the input and output document of the claims. The Examiner appears to take a position, without clearly stating so, that the inherent organization of an XML document as a set of storage units and logical structures somehow suggests that providing interpretation for such logical structures is well known. The Examiner does not mention how the alleged well-known prior art applies to the context of claim 61, involving interpretation information for input and output documents being provided to a node involved in a commercial transaction.

If the Examiner does not withdraw the rejection based upon other distinguishing features in the claims, Applicant requests that the Examiner provide evidence supporting the assertion of well-known prior art under MPEP § 2144.03, and that the alleged well known prior art be more clearly identified.

Accordingly, Applicant submits that the Examiner has failed to provide a *prima facie* case of obviousness for claim 61, and reconsideration is respectfully requested.

The Examiner extends the rejection to claim 72, which depends from claim 61. However, the Examiner does not identify how the processes involved in translation from XML to HTML as taught by Bayeh et al. suggest event listener programs that respond to events to execute a process in a commercial transaction, as required by claim 72. Furthermore, claim 72 is believed to be patentable for at least the same reasons as claim 61 from which it depends.

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Accordingly, clarification of the Examiner's rejection of claim 72, and/or withdrawal of such rejection, is respectfully requested.

The Examiner extends the rationale for rejection of claim 61 to claims 1, 17 and 39. However, Applicant submits that such claims are substantively different than claim 61.

Claim 1 recites a "machine-readable specification of an interface to transaction processes...." It is not clear what structure in Bayeh et al. corresponds to the claimed machine-readable specification of claim 1.

Claim 17 recites "programs of instruction ... providing tools to build a definition of the participant interface...." In addition, claim 17 recites programs of instructions "... to compile data structures...." Applicant respectfully submits that there is no similar teaching in Bayeh et al. Such claim is being pursued in a continuation application.

Claim 39 claims an apparatus that includes "tools to build a definition of the participant interface ..." and "a compiler ... to compile data structures" Again, there is no similar teaching in Bayeh et al. Such claim is being pursued in a continuation application.

The Examiner extends the rejection of claim 17 to claim 18, also based apparently on well-known prior art. Claim 18 recites a repository "storing a library of logical structures and interpretation information for logical structures used to build interface descriptions." However, Bayeh et al. includes no related structures, and the Examiner has failed to clearly identify what portions of claim 18 are considered to be well-known. Such claim is being pursued in a continuation application.

If the Examiner does not withdraw the rejection (in the continuation application) based upon other distinguishing features in the claims, Applicant requests that the Examiner provide evidence supporting the assertion of well-known prior art under MPEP § 2144.03, and that the alleged well-known prior art be more clearly identified.

Accordingly, reconsideration and withdrawal of the rejection of claims 1, 17, 18, 39, 61 and 72 is respectfully requested.

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Rejection of Claims 35 and 37-38 under 35 USC § 103(a)

The Examiner rejected claims 35 and 37-38 under 35 USC § 103(a) as unpatentable over Meltzer et al. (U.S. Patent No. 6,226,675 B1) and further in view of Sellers et al. (U.S. Patent No. 5,311,438). The Examiner stated that Meltzer et al. was being applied "as applied to claim 18 above." This is apparently a mistake, as Meltzer et al. was not applied explicitly to claim 18 anywhere in the Official Action.

In fact, Meltzer et al. does not qualify as prior art under § 102(e). The filing date of Meltzer et al. is the same date as the filing date of the present application. Applicant believes that the Examiner intended to reject these claims for obviousness-type double patenting.

As mentioned above, these claims have been canceled, without prejudice.

CONCLUSION

It is submitted that the present application is now in form for allowance, and such action is respectfully requested.

Respectfully submitted,

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ATTACHMENT UNDER RULE 1.121

In the Specification:

The paragraph beginning at page 1, line 12 of the specification has been amended as follows:

The present application is related to co-pending U.S. patent application No. [_____] 09/173,847, filed on [_____] 16 October 1998, [the same day as the present application, and having the same inventors,] now U.S. Patent No. 6,226,675 B1, entitled PARTICIPANT SERVER WHICH PROCESSES DOCUMENTS FOR COMMERCE IN TRADING PARTNER NETWORKS [19957-702)]; and

to co-pending U.S. patent application No. [_____] 09/173,854, filed on [_____] 16 October 1998, [the same day as the present application, and having the same inventors] now U.S. Patent No. 6,125,391, entitled MARKET MAKERS USING DOCUMENTS FOR COMMERCE IN TRADING PARTNER NETWORKS [19957-703)].